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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,112	11/13/2003	Mitsumasa Tsuchiya	019519-409	7708
21839	7590	03/02/2006	EXAMINER	
BUCHANAN INGERSOLL PC (INCLUDING BURNS, DOANE, SWECKER & MATHIS) POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			LE, HOA VAN	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/706,112	Applicant(s) TSUCHIYA ET AL.	
	Examiner Hoa V. Le	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 10 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-21 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24(broadest), 17-21, 23 and 25-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/901,676.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

This is in response to Paper filed on 10 January 2006.

- I. **Correction:** In the Office action mailed on 14 November 2005, under section “II”, it should be ---Claims 24 (broadest), 17-21, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (5,532,116) considered in view of Tanka et al (4,820,621).

- II. In view of the amendment filed on 10 January 2006. The applied set of the references with respect to Suzuki et al (5,532,116) and Tanka et al (4,820,621) in the Office action mailed on 14 November is withdrawn.

- III. The record shows that applicants rely on the limited Examples on page 95 for the newly added embodiment. The fact is that the tested developing solutions contain the surfactant “formula (I) Y” only. The language “ wherein the amount...” is not found or supported as urged. Please see the authority in *Tronze v. Biomet Inc.*, 3,USPQ2d 1403 for new matter issues.

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VI. The amendment filed on 10 January 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The language “ wherein the amount...” is not found or supported on page 95 of the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

V. Claims 24 (broadest), 17-21, 23 and 25-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The language “ wherein the amount...” is not found or supported on page 95 of the specification.

VI. Claims 24 (broadest), 17-21, 23 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (5,532,116) considered in view of Miller et al (5,466,559).

Suzuki et al disclose and teach an alkaline aqueous developing composition comprising up to 4 wt% of a polyoxyethylene (2-50 units) naphtyl ether known additive non-ionic surfactant being read on and/or within the general formula (I-B) in the claims. An amount of less than 2 wt% of a polyoxyethylene (2-50 units) naphtyl ether known additive non-ionic surfactant is not suggested or applied. Please see the whole disclosure of each of the applied reference, especially at col.9:39-42, 10:65-67, 11:7-10, 17:62-64 and 18:6-8).

Suzuki et al do not specify or cite the non-supported language “wherein the amount of the nonionic...”. However, at the level of one skilled in the art, one can use one or more types of surface active agents in a cleaning, washing out or developing solution to sufficiently enhance a cleaning, washing out or developing result. Workings to select a proper portion of surface active agents in a solution for cleaning, washing out or developing are conventional and routinely done to one having ordinary skill in the art.

Suzuki et al do not specify “an electrical conductance...” as that in claim 21. Tanka et al disclose and teach the use of about 90 g/l or their maximum amount to

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provide a pH solution of up to 14 of the strong charge sodium carbonate and sodium bicarbonate in the aqueous composition. It is reasonable that the aqueous has “an electrical conductance...” as claimed. The language “electrical conductance...” is a property of a material. It is allowed to request and require applicants to show or provide a convincing evidence to the contrary for a patentability of the claim in accordance to the authority stated in *In re Schreiber*, 44 USPQ2d 1429.

Suzuki et al do not specify or cite a conventional amount of a known additive chelating agent. Miller et al disclose, teach and suggest the use of from about 0.1 wt% of an alkali metal salt of citric acid chelating additive on col. 6:65 to 7:5 for a conventionally known advantage of obtaining a chelating result as wisely practiced in the art. Applicants should show or provide an evidence to the contrary. The applied “from about 0.1 wt% of an alkali metal salt of citric acid chelating additive on col. 6:65 to 7:5” is read citric acid in an alkaline solution in the claims. There is no suggestion of the use of an amount of the use of about 2 or more weight percent an alkali metal salt of citric acid chelating additive.

Since the above references are all related to additives to an alkaline developing solutions, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include, use or cite an effective

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amount of an alkali metal salt of citric acid additive chelating agent for a reasonable expectation of obtaining a effective chelating result as disclosed, taught and suggested in Miller et al.

VII. Applicant's arguments filed 10 January 2006 have been fully considered but they are not persuasive.

The record shows that applicants rely on the limited Examples on page 95 for the newly added embodiment. The fact is that the tested developing solutions contain the surfactant “formula (I) Y” only. The language “ wherein the amount...” is not found or supported as urged. Please see the authority in *Tronze v. Biomet Inc.*, 3,USPQ2d 1403 for new matter issues. The arguments base on the non-supported embodiment have and are given a little to no value.

Applicants urge that Suzuki et al developing solutions contain additional chemical ingredients. The arguments have little to no value since the newly amended embodiments find no support.

An applicable embodiment from a pieces of a prior art is not limited to a particular example. Should applicants limit their claims to Examples or one of them only in the specification in order for the arguments to have some merits?

The same chemical compounds in a developing solution would provide the same function. Applicants should show or provide a convincing evidence to the contrary for the arguments to have some merits.

The claimed amount of a chelating agent is in Miller et al. Miller et al disclose, teach and suggest the use of from about 0.1 wt% of an alkali metal salt of citric acid chelating additive on col. 6:65 to 7:5 for a conventionally known advantage of obtaining a chelating result as wisely practiced in the art. Applicants should show or provide an evidence to the contrary. The applied “from about 0.1 wt% of an alkali metal salt of citric acid chelating additive on col. 6:65 to 7:5” is read citric acid in an alkaline solution in the claims. There is no suggestion of the use of an amount of the use of about 2 or more weight percent an alkali metal salt of citric acid chelating additive.

VIII. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

IX. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

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<http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
27 February 2006

HOA VAN LE
PRIMARY EXAMINER
